Remarks:

Reconsideration of the above referenced application in view of the enclosed discussion and remarks is requested. Existing Claims 1 to 30 remain in the application.

ARGUMENT

Claims 1, 14 and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. This rejection is respectfully traversed and Claims 1, 14 and 20 are believed allowable based on the following discussion.

According to the Manual of Patent Examining Procedure at Sec. 2173, the primary purpose of the requirement of definiteness of claim language is "to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent." Another purpose is "to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention." [M.P.E.P. § 2173]

Regarding clarity and precision, the M.P.E.P. provides the following guidance as to what criteria should be adhered to in analyzing claims on indefiniteness:

> "The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:
>
> (A) The content of the particular application disclosure;
>
> (B) The teachings of the prior art; and
>
> (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made."
>
> [M.P.E.P. § 2173.02.]

Further the breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). "If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be

of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph." [M.P.E.P. § 2173.04]

Applicants' independent claims require that *the volume top file conforms to an Extensible Firmware Interface (EFI) specification.* It will be apparent to one of ordinary skill in the art that "an" extensible firmware interface specification may mean any of standard EFI specification versions existing at the time of filing, other similar specifications that are consistent with the EFI model of having modular, architecturally defined, components for build firmware. Applicants' claims have more *breadth* than to be limited to a specific version of an existing specification. Practitioners in pre-boot software systems and basic input output systems (BIOS) for personal computers, for instance Intel architecture or other similar architectures, will readily understand the advantages of using extensible firmware interface architecture rather than legacy BIOS. Those of ordinary skill in this art will also recognize through the disclosure in the specification that the present invention may be implemented without undue experimentation on a computing device subscribing to *an* EFI specification, and does not necessarily depend on an identified version of the specification. Moreover, as the Examiner asserts, it is understood by one of skill in the art that standards organizations may change technical specifications and that the specifications may evolve over time. However, it will also be understood by one of ordinary skill in the art that the basic premise to a standard has a basis in the original concept and model of the standard and remains true to the original philosophy of the technological art.

In this case, Applicants do not demand that the claimed EFI specification be a "standard" or controlled by a standards group. Applicants' claims also do not require that the EFI specification be limited to only one version of the specification. One of ordinary skill in the art will recognize that the term "an extensible firmware interface specification" means that someone or some entity has defined an extensible architecture having the general properties as described in the specification:

> "VTF file 42 is a file that conforms to a specification such as the Extensible Firmware Interface (EFI) specification which is designed to enable developers to easily implement different computing platforms. For example, the EFI specification describes a common framework with a set of core components, such as Plug-in Environment Initialization (PEI) and Driver Execution Environment (DXE) core files. The EFI specification provides a core framework and environment that is platform and Operating

> System (OS) independent. Moreover, the EFI specification is both a binary interface and API-set." [Specification, pages 7-8]

Thus, when Claims 1, 14 and 20 recite that the volume top file conforms to an EFI specification it will be understood that the VTF may conform to the standard EFI specification in any version that is consistent with the description in the specification. It also means that newly developed specifications having properties as described in the specification are equivalents to a "standard" specification. It will be apparent to one of ordinary skill in the art how to make, use and practice the invention based on the description and that the scope of the subject matter embraced by the claims is clear. Therefore the § 112 rejection is improper and should be withdrawn.

Claims1-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,081,890 to Datta (hereinafter, "Datta"), in view of U.S. Patent No. 6,816,963 to Krithivas et al. (hereinafter "Krithivas et al."). This rejection is respectfully traversed and Claims 1-30 are believed allowable based on the foregoing and following discussion.

Without conceding the propriety of combining these references, Applicants respectfully submit that Krithvas et al. cannot be used as a reference to render the present invention unpatentable. More specifically, Applicants respectfully point out that Krithvas et al. is co-owned by the assignee of the present application. As articulated in 35 U.S.C. 103(c):

> "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person"

Since Krithivas et al. does not qualify as a reference under 35 U.S.C. 102 (a), (b), (c) or (d), it may only be deemed prior art under 35 U.S. C. §102 (e), (f) or (g). As a result, pursuant to 35 U.S.C. §103(c), Applicants respectfully submit that Krithivas et al. does not preclude patentability of the presently claimed invention since Krithivas et al. and the presently claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. More specifically, Krithivas et al., which issued on Nov. 9, 2004 as U.S. Patent No. 6,816,963, is assigned to Intel Corporation, the

same entity to which the current application is assigned (assignment recorded on Apr. 1, 2002). As such, Applicants respectfully submit that Krithivas et al. is an improper reference for use against the presently claimed invention and Applicants request the Examiner to withdraw the rejection to Claims 1-30 under 35 U.S.C. §103.

CONCLUSION

In view of the foregoing, Claims 1-30 are all in condition for allowance. If the Examiner has any questions, the Examiner is invited to contact the undersigned at (703) 633-6845. Early issuance of Notice of Allowance is respectfully requested. Please charge any shortage of fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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s/Joni D. Stutman-Horn/

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